

IP Section Licensing Committee Meeting

Thursday, September 7, 2006, 8:30 a.m. — 9:30 a.m.

MINUTES

PARTICIPANTS: Kevin DeBré (Chair; kdebre@biztechlaw.com); Dana Shultz; Mary Harris; Brian Knapp (Acting Secretary); Jim Wright; Louise Nemschoff; Josh Hofheimer; Tony Sarabia; and Kevin Straw.

1. **Introduction:** Kevin DeBré welcomed the participants and the participants identified themselves.
2. **Social Mixers Update:** A discussion about scheduling social mixers (SoCal / NorCal) was tabled until the next call.
3. **Intellectual Property Section, Executive Committee Meeting:** Kevin attended the long-range planning meeting on July 28-29, 2006 and reported on the status of the Licensing Committee ("LC"). He reported that the LC is now 60 members strong, it has two continuing education programs scheduled in the near future, and that the LC holds monthly conference calls (which have recently included formal discussions around substantive licensing topics). Two continuing education panel sessions sponsored by the LC will be held at the IP Institute on November 4th and 5th and will address best practices in licensing and IP issues in the context of M&A transactions, beyond due diligence. The LC is also working with the Copyright and Trademark Committees on continuing education programs. Overall, the Executive Committee was impressed with the progress of the LC.
4. **Licensing Committee Web Page:** The LC has an opportunity to go beyond what currently appears on the web page, *e.g.*, link to valuable resources for practitioners. Members of the LC are asked to please send any ideas that you have for the LC web page to Kevin and/or present the same to the group on the next call.
http://www.calbar.ca.gov/state/calbar/calbar_sections_generic.jsp?cid=11471&id=21806
5. **Upcoming Meetings & Events:** Thursday, October 5, 2006 is the next monthly conference call, Marty Fern will present on the topic of "inadvertent franchises." Saturday, November 4, 2005 is the next quarterly LC conference call at which experts in an area outside of IP law will discuss topics relevant to licensing. The topic of the November 4 discussion will be governing law provisions in licensing agreements. Also, the 2006 IP and the Internet Conference, presented by the Copyright and Computer Law Committees of the Intellectual Property Law Section, will be held Friday, September 15, 2006 at The Beverly Hills Four Seasons
http://www.calbar.ca.gov/state/calbar/calbar_generic.jsp?cid=10707&id=20749.

6. **Internet Groups:** The LC is no longer supporting a Google Group or any other “group,” using the tools of a commercial entity for its members. For LC members looking for an alternative means to communicate with like-minded licensing practitioners, contact Lee Rawles (leerawles@paulhastings.com) regarding access to the CalLicensing Yahoo! Group (<http://groups.yahoo.com/group/CalLicensing>). This group is not affiliated with, or sponsored or endorsed by, the State Bar or the IP Section.
7. **Apparel Trends and Licensing Issues in the Apparel Industry, Legal Topic Discussion:** Greg Weisman, a partner with Silver & Freedman, led a discussion including: (a) background of the “west coast” apparel industry; (b) various licensing models – (i) straight distribution, (ii) ancillary products licensing, (iii) “bet the farm,” exclusive license; and (c) nuances in contracting within this industry – (i) distribution channel issues, (ii) defining “Net Sales,” particularly the types of deductions from gross sales that are typically permitted, and (iii) “No Knock Off” proviso; (c) the increase of M&A activity in this sector and (d) the status as well as the positives and negatives of copyright protection for apparel (please email Tony Sarabia at asarabia@cox.net for further information regarding the pending legislation in this area). Please contact Greg at gweisman@silfre.com for further details regarding this presentation.
8. **Next Conference Call:** The next monthly conference call of the Licensing Committee will be held on Thursday, October 5, 2006.

Meeting adjourned.